

**Remarks**

Claims 1-32 and 34 are currently pending in the application. Claim 21 was amended to correct a typographical error and claim 1 and 23 were amended to clarify the consumer's participation in the customized motor oil design process. Dependent claim 34 is newly added and support for the claim limitations can be found on page 2 lines 1-30 of the specification.

Claims 1-32 are rejected by the Examiner under 35 USC 103(a) as being unpatentable over anonymous article "Telco, LML, Apollo Tyres Tie up with Castrol," hereinafter "Telco," in view of one or more of U.S. Patent 6,182,048 ("Osborn"), U.S Patent No. 4,954,273 ("Denis"), U.S. Patent Application Publication No.2001/0047309 ("Bartholomew"), and official notice of the Examiner. Applicants respectfully disagree that the present claims are unpatentable as obvious.

The Examiner has the burden of establishing a prima facie case of obviousness. In order to establish obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one skilled in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all of the claim limitations. (see, MPEP 706.02(j)).

The Examiner has not established a prima facie case of obviousness because the prior art does not teach or suggest all of the claim limitations since 1) none of the references teach or suggest customizing motor oil for an individual consumer; 2) there is no suggestion or motivation to modify the Telco reference to analyze motor vehicle information by computer since Telco does not address customizing motor oil for an individual consumer; 3) a computer is not needed in Telco to analyze data in order to provide a motor oil selected on the basis of data input by an individual consumer.

The present invention is directed to ordering customized motor oil to meet a customer's specific needs using a wide area computer network or the internet. The customer may enter information relating to the type and age of car and the

conditions under which the customer's specific car is used. For example, the customer may enter information directed to whether or not the car is used for city or highway driving, in hot or cold temperatures, for hauling cargo or merely commuter driving. The computer analyzes the data and recommends an oil tailored to the needs of that customer who can then order the motor oil over the computer network.

Telco is the primary reference relied upon by the Examiner to establish a case for obviousness. However, Telco alone, or in combination with the other references, does not render the present invention obvious. Telco appears to be a press release from India announcing an arrangement between Castrol India and two vehicle manufacturers for Castrol to supply two new lubes – Castrol GTX and GTD – for the automotive manufacturers' diesel cars and two-wheel vehicles. Although the press release uses the term "customized," these lubricant offerings are not customized in the manner taught and claimed by the present application.

"Customized" in the Telco reference means that the lubricants meet the needs of an entire line or class of vehicles, i.e., two-wheelers or diesels, not the needs of a particular consumer. Moreover, Telco does not disclose a method by which consumers can participate in the design of their motor oils. The lubricants in Telco were designed by Castrol not the consumer. In the present invention the motor oil is customized by the consumer for the consumer's particular car and operating conditions of that car. This is clearly different from offering motor oils to OEMs for a certain class or line of vehicles. Thus, the foundation of the Examiner's argument fails as Telco does not disclose a method for obtaining a "customized" engine oil as claimed by the present invention. Once the foundation of the Examiner's argument fails then the rest of the argument fails as well as set out below.

**Claims 1-4** were rejected as obvious over Telco in view of Osborn. The Examiner alleges that Telco discloses providing a motor oil having user desired enhancements based on data including the type of vehicle and Osborn teaches analyzing motor vehicle related information by computer. However, as stated

above, Telco does not describe motor oil customized by the consumer using data input by the consumer to meet the consumer's particular requirements. Osborne is directed to a system and method for providing risk-based pricing for vehicle warranties. Osborne may collect data about the vehicle to be covered by the warranty but it is for the purpose of analyzing risk and not for providing a customized component for the car. Thus, Telco and Osborn together do not teach or suggest all claims limitations as neither suggest a method for permitting a consumer to participate in the design of a customized motor oil.

Relying on Telco, Osborne and official notice, the Examiner asserts that **Claims 5-7** are obvious because it would have been obvious to one of ordinary skill in the art of electronic commerce to analyze the data input by the consumer by computer and provide an engine oil responsive to the data analysis. However, Telco does not describe analyzing data input by a consumer or providing a customized motor oil based on such data and, as stated above, Osborne is not directed to motor oils at all. Osborne may collect data but not for the purpose of allowing the consumer to design their own motor oil or their own warranty. Moreover, it may be well known to obtain data by displaying a questionnaire on a computer screen, but it is not known or obvious to obtain data from consumers to permit them to design a motor oil customized to their individual needs. The invention must be considered as a whole and cannot be found obvious because individual steps may be known. Thus, Telco, Osborn together with the Examiner's official notice do not teach or suggest all claims limitations as nothing suggests a method for permitting a consumer to participate in the design of a customized motor oil.

The Examiner also combines Denis with Telco and Osborne to allege that the composition of the customized motor oil in dependent **claims 8-12, 14, 15 16, 21 and 22** are obvious. However, regardless of what the Examiner states, Denis does not teach a "customized motor oil," but an over-based salt additive for crankcase oils. The consumer may not tailor the crankcase oil in Example III of Denis to suit their needs. Example III merely provides a fully blended crankcase oil with a slate of additives. The present applicants are not claiming

the composition of the motor oil but the method of obtaining a customized motor oil to suit a consumer's needs.

Finally, the Examiner combines Bartholomew with a) Telco and Osborn to support his argument for obviousness of **claims 23, 24 and 25**; b) Telco, Osborne and official notice to reject **claim 26**; and c) Telco, Osborn and Denis to reject **claims 27-32**.

It is questionable whether Bartholomew is prior art under 102(a), (b) or (e) since the Bartholomew application published on November 29, 2001 and the Applicants' priority date is April 12, 2000. It follows that Bartholomew was not patented or described in a printed publication more than one year prior to filing date of the present application as required by 102(b), nor described in a printed publication or published in a patent application before the invention by the present applicants as required by 102 (a) and (e)(1). Despite its questionable status as prior art, Applicants will address the Examiner's rejections based on Bartholomew.

Bartholomew is directed to a Nail Polish Color Selection System and Method. While Bartholomew mentions that their invention may be modified for other applications that require custom formulation fluid dispensing, such as custom health and beauty aids, fragrances and lubricants, Applicants are not convinced that Bartholomew was contemplating lubricants/motor oils as opposed to gels, creams and body lotions given the context of the patent application. As such, there is no motivation to combine these references and the Examiner is clearly using hindsight to combine 3-4 references find the present invention obvious.

Even if the combination of three or four references was appropriate, a *prima facie* case of obviousness has not been made as a limitation in **claims 23-32** of the present invention is still missing -- consumer participation in the design of their motor oils base on the user's vehicle's specific lubrication needs -- which despite Examiner's argument, Telco, Denis and official notice does not provide. Equally, the addition of Denis cannot render **claims 27-32** obvious as it is not directed to "customized motor oil," but an over-based salt additive for crankcase

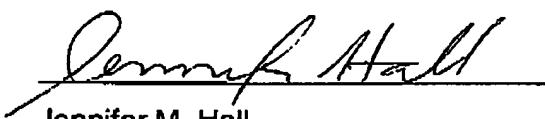
oils which the consumer may not tailor to suit their needs. Likewise, it may be well known to obtain data by displaying a questionnaire on a computer screen as in **claim 26**, but it is not known or obvious to obtain data from consumers to permit them to design a motor oil customized to their individual needs.

In conclusion, the Examiner failed to establish a *prima facie* case of obviousness because the references do not teach or suggest all of the claim limitations. When the invention is considered as a whole instead of the sum of its parts, it is not obvious in view of the references combined and applied by the Examiner. Accordingly, Applicants respectfully request that the Examiner allow pending claims 1-32 and new claim 34.

If the Examiner believes an oral or telephonic interview would advance the prosecution of this case, the Examiner is encouraged to contact Applicants' attorney at the Examiner's convenience.

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Respectfully submitted,



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